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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ASICS Corporation

Serial No. 76190823

Adam J. Thurston of Bryan Cave LLP for ASICS Corporation.

Raul Cordova, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Walters, Bucher and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by ASICS Corporation to
register the mark KEEP RUNNING for goods which were amended to
read "athletic shoes" in International Class 25.¹

The trademark examining attorney has refused registration
under Section 2(d) of the Trademark Act on the ground that
applicant's mark, when applied to applicant's goods, so resembles

¹ Application Serial No. 76190823, filed January 8, 2001, based on an
allegation of a bona fide intention to use the mark in commerce. The
examining attorney's initial requirement for a disclaimer of RUNNING
was later withdrawn.

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the marks for the goods identified in Class 25 in the following two registrations (both issued to Diageo Brands B.V.), as to be likely to cause confusion.

Registration No. 2682152 of the mark KEEP WALKING (in standard character form) for:²

clothing, namely, shirts, suits, pants, slacks, jeans, shorts, sweaters, hosiery, socks, ties, belts, scarves, gloves, skirts, blouses, blazers, jackets, coats, sport coats, raincoats, overcoats, t-shirts, warm-up suits, jogging suits, bathrobes, underwear, boxer shorts, nightgowns, pajamas, camisoles, aprons, vests, sweatshirts, swim suits, headbands, wrist bands, caps, hats, visors. International Class 25.

Registration No. 2616316 of the mark shown below



for:³

² Issued on February 4, 2003 under Section 44(e) of the Trademark Act. The registration also includes the following goods in Classes 28 and 33: "sporting goods, namely, footballs, baseballs, flying discs, table tennis balls and table tennis paddles, skipping ropes, miniature trampolines, stationary exercise bicycles, golf balls, golf clubs, fishing rods, fishing tackle and bags and boxes therefor, tennis rackets, tennis balls, badminton rackets, skis, snowboards, skateboards, surfboards, and windsurfing boards" in International Class 28; and "alcoholic beverages, namely, whiskey and alcoholic beverages containing whiskey" in International Class 33.

³ Issued on December 10, 2002 under Section 44(e) of the Trademark Act. The registration also includes the following goods in Classes 28 and 33: "sporting goods, namely, footballs, baseballs, flying discs, table tennis balls and table tennis paddles, skipping ropes, miniature trampolines, stationary exercise bicycles, golf balls, golf clubs, fishing rods, fishing tackle and bags and boxes therefor, tennis rackets, tennis balls, badminton rackets, skis, snowboards, skateboards, surfboards, and windsurfing boards" in International Class

clothing, namely, shirts, suits, pants, slacks, jeans, shorts, sweaters, hosiery, socks, ties, belts, shoes, sneakers, sandals, slippers, scarves, gloves, skirts, blouses, blazers, jackets, coats, sport coats, raincoats, overcoats, t-shirts, warm-up suits, jogging suits, bathrobes, underwear, boxer shorts, nightgowns, pajamas, camisoles, aprons, vests, sweatshirts, swim suits, headbands, wrist bands, caps, hats, visors. International Class 25.

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was not requested.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue, including the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to a consideration of the goods. The goods in Registration No. 2682152 are, in part, legally identical to the goods identified in the application. Applicant's athletic shoes are fully encompassed within the broadly identified "shoes and sneakers" in that registration. Athletic shoes are otherwise closely related to the goods in both registrations. There is an obvious relationship between athletic shoes and exercise wear such as warm-up suits, jogging suits, sweatshirts, socks,

28; and "alcoholic beverages, namely, whiskey and alcoholic beverages containing whiskey" in International Class 33.

headbands and wrist bands. In addition, the examining attorney has submitted a number of third-party registrations showing in each instance a mark which is registered for footwear, on the one hand, and one or more clothing items and/or accessories identified in the cited registrations, on the other. These third-party registrations, while not evidence of use of the marks therein, tend to show that purchasers would expect the types of products offered by applicant and registrant, if sold under similar marks, to emanate from the same source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988).

Applicant maintains that there are substantial differences between the types of goods identified in the application and cited registrations as well as differences in the trade channels for the goods. In support of this position, applicant has submitted pages from what it claims is registrant's website, www.johnniewalker.com. While noting that it could not find use of KEEP WALKING on the website in connection with any Class 25 goods, applicant argues that registrant is a world famous supplier of whiskey under the brand name JOHNNIE WALKER; that registrant has built up substantial good will in the mark KEEP WALKING in connection with whiskey; that the identified shoes and clothing are sold in promotion of its whiskey products; and that relevant purchasers would recognize that the products are

collateral to registrant's primary goods. In this regard, applicant also notes the inclusion of whiskey in both registrations. Applicant contends that registrant's collateral goods, unlike applicant's athletic shoes, would likely be provided exclusively through trade channels where whiskey is sold or promoted. Applicant argues that in contrast to registrant's business, applicant is a world famous manufacturer of high performance athletic shoes under the marks ASICS and KEEP RUNNING; that applicant's goods are sold to athletes and people interested in running or fitness; and that its goods are sold through trade channels where athletic shoes are sold.

Applicant's presumptions about registrant's clothing and what purchasers would know or think when confronted with the respective marks on the goods are not relevant. The question of likelihood of confusion is determined on the basis of the identification of goods set forth in the application and registrations, rather than on the basis of what the record may reveal as to the nature of the goods, or the actual channels of trade or purchasers for the goods. See *J & J Snack Foods Corp. v. McDonalds Corp.*, 932 F.2d 1460, 1464, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Registrant's clothing, as identified, is not limited to a promotional function for its alcoholic beverages. Further, we will not infer any such restriction from the inclusion of Class 33 (alcoholic beverages) in the registrations, or speculate as to how registrant's marks are or will be used. In the absence of any specific restrictions to the Class 25 goods, it must be presumed that registrant's clothing would be used for all the usual purposes, that they would reach all classes of customers including applicant's customers; and that they would be sold through all normal channels of trade, including the usual retail outlets for such goods.

Applicant's arguments regarding the cost of its athletic shoes and the sophistication of those who purchase them are equally unpersuasive. There is no evidence that athletic shoes in general are necessarily expensive or that the purchasers for such goods are sophisticated. See *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001) and *In re Bercut-Vandervoort & Co.*, 229 USPQ2d 763 (TTAB 1986) (both cases rejecting the applicants' arguments regarding the high cost of their wines and the sophistication of their purchasers, where the applications identified goods merely as "wine."). In fact, athletic shoes may be purchased not only by "athletes," as applicant contends, but by ordinary consumers for their everyday workout activities. We have no evidence that

ordinary purchasers of athletic shoes would exercise anything other than ordinary care in selecting such products.

It is clear that if these legally identical and closely related goods are offered under similar marks there would be a likelihood of confusion.

We turn then to the marks. Applicant maintains that the marks KEEP RUNNING and KEEP WALKING (with and without the design) are entirely different in sound and appearance; and that they "connote drastically different ideas" and create different commercial impressions. Brief at 3. Applicant argues that the term KEEP WALKING is used as a marketing theme to promote registrant's line of whiskeys and that in contrast to the connotation associated with the consumption of whiskey, applicant's mark has the connotation of physical exercise. Further, according to applicant, its mark KEEP RUNNING is always used in connection with its "world famous line of ASICS' athletic shoes, in particular running shoes." Brief at 4. Applicant contends, based on registrant's website, that the design in Registration No. 2616316, known as the "Striding Man," is a major component of registrant's KEEP WALKING marketing theme used to promote registrant's world famous line of whiskeys sold under the JOHNNIE WALKER brand; that the "Striding Man" is also featured prominently on registrant's whiskey bottles; and that consumers

who encounter the design will instantly associate the design with registrant's brand of whiskeys.

When applicant's mark KEEP RUNNING and registrant's marks KEEP WALKING, with or without the design, are considered in their entireties and in relation to the shoes and clothing offered thereunder, we find that the overall similarities in the marks strongly outweigh their differences. The marks are similar in sound. They are both three-syllable phrases, with identical beginning and ending syllables, and they both have the same cadence when spoken. Further, the marks convey substantially similar meanings and overall commercial impressions. As the examining attorney points out based on dictionary definitions of the two terms, running is simply a faster version of walking. Thus, the two slogans convey a very similar message or instruction in relation to athletic shoes and exercise wear such as jogging suits. In addition, the design in Registration No. 2616316, which suggests a man in walking motion, merely serves to reinforce the meaning of the phrase KEEP WALKING. Purchasers familiar with registrant's marks KEEP WALKING marks for exercise clothing and shoes, which could include running and walking shoes, may well assume that KEEP RUNNING identifies a related line of clothing or shoes by registrant.

Applicant's contentions regarding the asserted fame or recognition of ASICS or JOHNNIE WALKER marks are not relevant.

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ASICS is not part of applicant's mark and JOHNNIE WALKER is not part of registrant's marks. Moreover, applicant's claim that purchasers are familiar with the design in registrant's mark or would associate it with JOHNNIE WALKER as used in connection with clothing is speculative. There is no evidence of any use of JOHNNIE WALKER or the design in connection with clothing. More important, the commercial impression of a mark is not determined by extrinsic evidence as to its affiliation with a particular entity. The question is whether purchasers will believe that the goods offered under the respective marks come from the same source, not whether purchasers can identify the source for the goods.

Applicant argues that the existence of a number of third-party registrations for marks that include the term KEEP, or KEEP with additional wording followed by the suffix "ING," for goods in Class 25, including several for footwear, show that these terms are commonly used in connection with clothing and that the cited marks are weak for these types of goods.⁴ Examples of these third-party registrations are KEEP AUSTIN WEIRD (Registration No. 2770544); KEEP TAHOE BLUE (Registration No. 2831888); KEEP YOUR HEAD IN THE GAME (Registration No. 2282572); KEEP RIGHT (Registration No. 2207591); KEEP IT REAL (Registration

⁴ The pending applications submitted by applicant are not evidence of anything except that the applications were filed in the Office.

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No. 2491222); KEEP IT DIGITAL STUPID (Registration No. 2149634);
KEEP ON CHARGIN (Registration No. 2306677); and KEEP DIGGIN
(Registration No. 2732848).

None of the marks shown in the third-party registrations for Class 25 goods contains the words KEEP and WALKING or anything similar to that slogan or combination of terms. The word KEEP is used in all of the third-party registrations as part of unitary marks having entirely different meanings and commercial impressions than the marks cited herein. The third-party registrations do not show that purchasers would be able to distinguish between applicant's and registrant's very similar marks for identical and closely related goods.

While the mark KEEP WALKING may be suggestive of registrant's goods, and therefore not entitled to a broad scope of protection, the mark is at least entitled to protection from registration of a similar mark for identical and closely related goods. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion is to be avoided as much between weak marks as between strong marks).

Finally, applicant's contention that there has been no actual confusion is entitled to little weight. The application is based on an intention to use the mark in commerce with no indication that use has actually commenced. Nor is there

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evidence of any use of the registered marks for clothing. Without evidence that there has been any opportunity for confusion to arise, the lack of actual confusion is not meaningful.

In view of the similarity of the marks, and because the goods are identical and otherwise very closely related, we find that confusion is likely.

To the extent that there is any doubt on the issue of likelihood of confusion, such doubt must be resolved in favor of the prior registrant. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).

Decision: The refusal to register under Section 2(d) is affirmed.